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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,755	07/31/2003	George Nikolov	KM102	8449
7590 01/11/2006			EXAMINER	
Michael J. Foycik, Jr. #255 1718 M St. N.W. Washington, DC 20036			STOKES, CANDICE CAPRI	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,755

Applicant(s)

NIKOLOV, GEORGE

Examiner

Candice C. Stokes

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 9 is objected to because of the following informalities: In line 4 of page 14, the phrase “and a smoothly curved” appears to be missing a word. For examination purposes, the phrase is taken to be “and a smoothly curved surface”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In amended claim 1, it is now claimed that the handle and intermediate portions of the forceps are “adapted to be readily sterilizable by preventing lodging of biological matter an to prevent injury to the mouth of the patient. There is no support for this provided in the originally filed specification and therefore this is considered to be new matter. For examination purposes the claims have been treated as presented in the Amendment and Response filed 10/31/05.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowler,III et al (USPN 5,197,879). Fowler,III et al disclose sterilizable lower mandibular tooth extraction forceps 10 having a working position and a separation position comprising a first component 13 having a handle 14 and an intermediate portion 16. The intermediate portion 16 has an oblong central body portion, which connects handle 14 to a beak. The handle and intermediate portion have smoothly contoured surfaces. Fowler,III et al disclose “the nose section 18 illustrated in the figures corresponds to a pair of bird beak pliers” (col. 2, lines 52-53). The intermediate portion 16 of the first component 13 has two opposed extending elements 38 and two opposed groove portions 28 disposed about a periphery of the intermediate portion 16 of the first component 13. The extending elements 38 are relatively thin and have straight edge portion 44 and a smoothly curved portion 42 with an edge approximating a circular arc as shown in Fig. 5. Further, the straight edge portions of the opposed extending elements 38 of the first component 13 has respective straight flat edges extending approximately collinearly with each other and the central body portion of the first component 13 has a substantially flat side and an opposite side which is smoothly contoured so as to have no sharp edges. There is also disclosed a second component 12 comprising the same elements as the first component 13. “Fig. 8 shows a first and second component 12,13 in an extreme open position or separation position with one

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half rotated 180° around its long axis Y. In the extreme open position or separation position the male dovetail protrusions lie outside and adjacent the corresponding female dovetail section or opposed groove portions 28, thus permitting disengagement of the first and second components 12,13 such as for sterilization purposes. Rotating the second component 12 around the axis Z relative to the first component 13 in the counterclockwise direction will cause each male dovetail protrusion or extending elements 38 to enter the corresponding female dovetail protrusion or opposed groove portion 28. As the second component 12 is further rotated counterclockwise, the extending elements 38 will enter the opposed groove portions 28 and the mating surfaces C,D and A,B of the extending elements 38 and the opposed groove portions, respectively, will engage” (col. 4, lines 18-32). This is the working position and in this position the substantially flat side of the extending elements 38 extending from the central body portion of the first component 13 is in facing contact with the flat side of the extending elements 38 of the central body portion of the second element 12. Fig.1 shows the angled beaks. As to Claims 2-3 and 10-11, Fig. 1 shows the beaks of the first and second components 12,13 extend generally in parallel and transversely with a centerline between the handle portions 14. Regarding Claims 4 and 12, Fowler, III et al disclose “preferably the first and second components are constructed of 440C stainless steel” (col. 6, lines 1-2). As to Claim 8, Fowler,III et al teach “some separable hinged tools separate too easily, thus causing the problem of unwanted separation in some circumstances” (col.1, lines 40-43). Thus, it is inherent that the forceps disclosed by Fowler,III et al while in working position the first and second components will be retained in their relative positions by frictional forces therebetween.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 5-6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler,III et al. Fowler,III et al disclose the claimed invention except for the first and second components composed of plastic or a transparent material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the first and second components from plastic or any material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter or obvious design choice. *In re Leshin*, 125 USPQ 416.

2) Claims 7 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler,III et al in view of Williams et al (USPN 6,739,744). Fowler,III et al disclose the claimed invention except for the forceps comprising a lamp element attached to a free end of a handle portion of the first component. Williams et al tech “referring now to Fig. 12, there is shown an illuminated forceps 107 having an integrated delivery system. Forceps 107 is generally comprised of light distributors 860 and light emitters 810. Each light distributor 860 includes a pair of arms 870 and a pair of connecting members 862. Connecting members 862 connect to mating connecting members 896 of light source cables 894. Cables 894 connect to a light source (not shown). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the light source or lamp element as taught by

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Williams et al into the forceps disclosed by Fowler, III et al in order to provide means for illuminating the forceps during use.

As to Claims 15-16, Fig. 1 shows the beaks of the first and second components 12, 13 extend generally in parallel and transversely with a centerline between the handle portions 14.

Further as to Claims 17-18, Fowler, III et al disclose the claimed invention except for the first and second components composed of plastic or a transparent material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the first and second components from plastic or any material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed 10/31/05 have been fully considered but they are not persuasive. In Applicant's remarks it appears that they are attempting to show the differences between the claimed invention and the prior art of record. Initially Applicant submits "the Fowler II references does not meet the claimed limitations of the amended claims because "the device of Fowler III, while 'sterilizable' only in the broadest sense, is clearly not adapted to be sterilized as is the device of the present invention as claimed. In Response, it is the Examiners position that the device as originally claimed and disclosed is only capable of being sterilized. Now applicant has amended the claims without support in the specification for these amendments. Further, the Fowler II reference is capable of being sterilized.

As to the remaining arguments presented by the Applicant they are all directed to features not claimed in the application and therefore are non-persuasive.

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Accordingly Claims 1-8 remain rejected and claims 9-18 are newly rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714.

The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Candice C. Stokes


Cary E. O'Connor
Primary Examiner